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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,928	04/14/2000	Thierry Delplanche	32232-159912	8898

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EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

12

DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-12

Office Action Summary	Application No. 09/549,928	Applicant(s) DELPLANCHE ET AL.	
	Examiner Margaret B. Medley	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 9, 14, 17, 19-25 and 27-34 is/are rejected.
- 7) ☒ Claim(s) 10-13, 18 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim 18 is objected to because of the following informalities: The "p" between "nitro" and phenyloxycarbonyl) phenylalanine" should be deleted for the correct spelling of the said compound in the said claim. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 8 and 19-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 27 (and its dependent claims) are indefinite for the phrase "at least one Z_1 and/or Z_2 is a substituent ...or both" because it is unclear as to the scope of protection that applicants are seeking.

Claims 20 and 29 are indefinite for the substituted phrase "unsubstantiated" that is redundant and for the phrase "substituted" that is broader than the claim from which each claim depends.

Claims 23, 25, 32 and 34 are indefinite and unclear because the R , R_{3+} and R_{2+} substitutions have not been defined.

Claims 18 and 26 are indefinite in that they appear to duplicate each other.

Claim 26 is indefinite for the (*) asterisk appearing in the formula and for not being defined.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-9, 14, 17, 19-25 and 27-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gary et al "Preparation and Properties of Some alpha Azo-amino-acid Derivatives, Their Possible Use in Peptide Synthesis", note compound 5 of page 741, column 1, lines 6⁺ for "2, 4-dinitrophenyloxycarbonyl phenyl alanine" which anticipates the claimed reagents.

Claims 8-9, 14, 17, 19-25 and 27-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ryono et al 4,885,292.

Note column 35, lines 47-59 for a solution comprising N-[(4-Nitrophenoxy)carbonyl]-L-phenyl alanine, methyl ester that clearly anticipates the claimed compounds and solution comprising said compounds.

Claims 8-9, 14, 17, 19-25 and 27-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Patel 5,217,958.

Note column 22 for compounds LXIV and LXVIII and column 82 lines for the compound A. N-[(4-Nitrophenoxy)carbonyl]-L-phenyl alanine, methyl ester and a solution containing said compound that clearly anticipate the claimed compounds and solutions comprising said compounds.

Claims 8-9, 14, 17, 19-25 and 27-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Norbeck et al 5,461,067.

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Note column 33 lines 15-28 for the compound D.N-(((4-Nitrophenyl)oxy)carbonyl)-Lvaline Methyl Ester and solution comprising said compound that clearly anticipates the compound and solution comprising said compound.

Claims 8-9, 14, 17, 19-25 and 27-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Alrazzak et al 5,484,801.

Note column 17, line 55-end for compound R.N-(((4-Nitrophenyl)oxy)carbonyl)-L-valine Methyl Ester and solution comprising said compound that clearly anticipates the claimed compound and solution comprising said compound.

The restriction requirement is proper for reasons made of record in Paper No. 4 dated April 9, 2001.

Claims 10-13, 18 and 26 appear to contain allowable subject matter and would be allowed if written in independent claim format including all of the limitation of its intervening claims.

The prior art cited but not applied further teach reagents of the same nature as claimed by applicants.

Any inquiry concerning this communication from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can generally be reached on Monday--Friday from 7:30 a.m. to 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 3018-066.

M.B. Medley/dh
November 6, 2002


MARGARET MEDLEY
PRIMARY EXAMINER